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09/286,304 04/06/99 GIULIANI

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/286,304

Filing Date: 04/06/99

Appellant(s): JOHN A. GIULIANI ET AL.

Richard A. Neifeld
For Appellant

EXAMINER'S ANSWER

MAILED
AUG 28 2001
Technology Center 2100

This is in response to appellant's brief on appeal filed 03/23/01.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 10-13, 15, 17-20, 22 and 24 stand or fall together, claims 14 and 21 stand or fall together and that claims 16 and 23 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Deaton et al. (US Patent No. 5,687,322 11/11/1987)

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al (US Patent No. 5,687,322).

As per claims 10 and 24, Deaton et al teaches a method and system for selective incentive point-of sale marketing in response to customer shopping histories. Note the abstract. The system of Deaton et al also comprises a storage means for storing incentive data and means for

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selecting incentive data from the storage means depending upon the purchase of a first item. Note column 69, lines 14-33. The purchase of a first item relates to the price of the first item. Deaton et al does not explicitly teach selecting incentive data based on the price of a second item. Deaton et al teaches providing incentive data based on a dollar amount and the number and type of items purchased. Note column 69, lines 35-46 and column 101, lines 39-59. It would have been also obvious to one of ordinary skill in the art at the time the invention was made to also select incentives based on the price of a second item in order to allow customer loyalty on purchasing a specific type of product as suggested by Deaton et al.

As per claims 11-13, Deaton et al discloses printing and dispensing coupons to the purchaser of the item. Note column 69, lines 14-46.

As per claim 14, Deaton et al teaches a customer may purchase one or more items. Deaton et al also teaches that their system provides inducement coupons that can be combined. Note column 74, lines 7-17 of Deaton et al. Moreover providing more than one incentive for a given purchased item is well known in the art. Auto dealers and car dealers usually give a manufacturer incentive or a cash rebate or an additional item that was an option so that a sales of an automobile may be finalized. The customer has the option to select one of the incentives. Doing the same in the system of Deaton et al would have been obvious to the skilled artisan in order to make the system attractive to different types of customers.

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As per claim 15, selecting incentive data based upon a difference in price between the first and the second item would have been obvious to the skilled artisan because Deaton et al teaches providing incentive data based on dollar volumes.

As per claim 16, Deaton et al also discusses providing incentives in which purchased items are competitive items. Note column 69 lines 25-30.

Claims 17-23 contain limitations addressed in claims 10-16 respectively and therefore are rejected under a similar rationale.

(11) *Response to Argument*

Appellant argues that the Examiner has failed to establish a prima facie case of obviousness and cites In re Fine 837 F.2d 1071, 5 USPQ supporting their assertion.

In response, the Examiner has properly established a prima facie case in applying the Deaton reference against the instant claimed invention. Deaton is directed to providing incentives or coupons to purchasers based on several criteria or signals, random or lottery coupon. Note the abstract, column 75, lines 8-27, column 101 line 40 to column 105, line 42 and column 114 of Deaton. Deaton et al abundantly provides various schemes for providing coupons/incentives to customers at a point-of-sales. Deaton further teaches generating coupons based upon the number and types of products bought by a purchaser (column 101, lines 39-59) and based on a competing product purchased by a customer. Note column 69, lines 25-34..

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When a user purchases an item, the system of Deaton et al generates a coupon based on that purchased item. When an item is purchased, the item and the price of that item are known. Deaton also teaches generating coupons based on a dollar amount purchased by a shopper. Note column 69, lines 35-38. Thus, if the customer selects one item exceeding a predetermined dollar amount. Then, it would have been obvious to one of ordinary skill in the art that the generated coupons would have been based on the purchase of that item and on the price of that item since a determination would have then been made on whether the price of that purchased item exceeds a dollar amount.

Deaton et al further teaches determining the purchase of a competitive item and generating coupons based on the purchase of that competitive item. The competitive item may be viewed as a second item. Note column 69, lines 26-29. It would have been obvious to one of ordinary skill in the art at the time the invention was made when viewing the teachings of Deaton et al to select incentive data depending upon the purchase of a first item, the price of the first item and the price of a second item in order to widen the criteria when generating coupons so as to attract more customers to the system and also to allow customer loyalty on purchasing specific types of products.

The appellant then argues that Deaton provides no motivation for providing incentives based on the difference in price between a purchased product and second product.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, such a feature is only recited in independent claims 14 and 21. Deaton also teaches referring to a purchase history file in providing/generating coupons when a purchased transaction is initiated. A purchase transaction involves the purchasing of many items. The purchase of an item involves considering a first item and the price of that first item. All other items being purchased at that instant are considered as second items. Some of these second items may also be viewed as competitive items. As noted, Deaton et al also teaches generating coupons based on the purchase of a competitive item. Deaton teaches generating coupons based on purchased items and on the dollar amount of the purchased items (column 69, lines 35-46). The Examiner notes that the price of each purchased item is being considered in determining the dollar amount. Generating an incentive coupon based upon a price difference between a first item and a second item would have been obvious to one of ordinary skill in the art in order to encourage shoppers to purchase many types of items especially out of season items and/or items not easily sold for particular reasons.

Appellant then states that Deaton et al based their incentives on the customer's previous purchase found on a purchase history file and argues that Deaton et al does not disclose or

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suggest using the relationship of the price for the customer's current purchase with the price of a second product to create an incentive for the customer to make future purchase.

In response, appellant claims do not positively recite a past purchase, a current purchase or a future purchase. Thus arguments regarding the time of purchase or the condition for providing or generative incentive coupons based on time are not convincing.

In any event, providing the same incentive based on a current purchase would have been obvious to the skilled artisan for the same reason given above and because the timing of a transaction does not affect the functioning of providing incentives.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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PRIMARY EXAMINER

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